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EXAMINER

EDMONDSON, LYNNE RENEE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1725

DATE MAILED: 11/05/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/736,958

Applicant(s)

COSTIN, DARRYL

Examiner

Lynne Edmondson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-31.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, 6-9, 11-13, 15, 16, 19-24 and 26-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-8, 14, 20, 31, 41-57, 61, 62 and 64-71 of U.S. Patent No. 5990444.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims teach the same invention as the '444 claims but define the pattern scribes as a camouflage pattern. Both sets of claims teach use of an output file to control formation of the pattern on denim, energy densities per unit time and a plurality of images formed with different colors by varying intensity. Although the term "duty cycle" is not used in '444 claim 61, the step performs the same function as the duty cycle in instant claims 6 and 16. Although the '044 patent does not describe the pattern as camouflage (a pattern comprising different shades), claims 14, 20, 31 and 55 teach forming a graphic pattern at different levels of energy density to form

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different shades without completely penetrating the material. The instant claims teach the exact same method but use the term "camouflage" rather than regions of different shades. However, the method and results are identical. The '044 claims teach fading different parts of the material by applying different energy densities which forms different shades and different colors. See '044 claims 41-55, 48, 55 and 68-71.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use to method to scribe a variety of types of graphics with differently shaded areas including but not limited to camouflage, rounded and lined patterns in a reliable and controlled manner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 13, 15, 20-24, 26 and 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Costin et al. (USPN 5916196).

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Costin teaches a method of forming a graphic pattern which can be any shape such as curved and wavy faded lines (camouflage pattern) (col 3 lines 1-14, col 20 lines 8-31 and col 30 lines 30-42) using an interface associated with a computer comprising an output file to control pattern formation on a textile (col 2 lines 1-34 and col 6 lines 4-22). The pattern may be defined by a single output file or combination thereof wherein an image is formed in a plurality of locations with different laser parameters to achieve particular characteristics (col 2 lines 35-43 and lines 56-67). Laser intensity may be varied to form multiple colors while operating within a range that will not damage the fabric (col 17 line 46 – col 18 line 38 and col 26 line 48 – col 27 line 30). Laser output may be expressed in a variety of ways including energy density per unit time (col 28 lines 18-25 and claims 6-9). The material may be denim (col 30 lines 12-25). The laser is controlled to scan in lines with varying power (col 20 lines 5-31). The shape may have multiple rounded edges, polygonal portions or form cow-type spots (filled in circles) (col 3 lines 1-13, col 17 lines 4-27, col 18 lines 5-38 and figures 7, 21, 36 and 40). Plaid patterns and polka dots may also be formed (col 19 lines 47-67 and figures 17-18).

4. Claims 1-3, 5 and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Costin et al. (USPN 5916461).

Costin teaches a method of forming a graphic pattern which can be any shape such as wavy faded lines (camouflage pattern) (col 1 lines 28-45 and claim 5) using an interface associated with a computer comprising an output file to control pattern

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formation on a textile. The pattern may be defined by a single output file (col 8 lines 51-56) or combination thereof wherein an image is formed in a plurality of locations with different laser parameters to achieve particular characteristics (col 5 lines 21-43) including color (col 6 lines 33-41). Laser intensity may be varied to form multiple patterns in multiple areas (col 7 lines 16-40 and col 11 lines 19-67) while operating within a range that will not damage the fabric (col 7 lines 49-67 and col 9 lines 21-52). The material may be denim (col 2 lines 17-25). The laser is controlled to scan in lines with varying power (2 line 60 – col 3 line 16 and col 11 lines 1-18). Random patterns are formed with the aid of a random number generator (col 7 lines 37-41 and col 8 lines 1-12). The shape may have rounded edges, polygonal portions or form cow-type spots (filled in circles) (col 7 lines 30-35 and figure 10c). See Costin claims 5-10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 11, 12 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin et al. (USPN 6252196 B1).

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Costin teaches a method of forming a graphic pattern which can be any shape such as curved and wavy faded lines (camouflage pattern) (col 3 lines 1-14, col 20 lines 8-31 and col 30 lines 30-42) using an interface associated with a computer comprising an output file to control pattern formation on a textile (col 2 lines 1-34 and col 6 lines 4-22). Although the term camouflage is not used, a camouflage pattern is recognized as a random pattern of wavy lines with light and dark areas which may be different colors (col 2 lines 35-39). Regardless of the name given to the pattern the method and structure are identical. The pattern may be defined by a single output file or combination thereof wherein an image is formed in a plurality of locations with different laser parameters to achieve particular characteristics (col 25 lines 35-43 and lines 56-67 and col 25 lines 24-37). Laser intensity may be varied to form multiple colors while operating within a range that will not damage the fabric (col 2 col 17 line 46 – col 18 line 38 and col 26 line 48 – col 27 line 30). Laser output may be expressed in a variety of ways including energy density per unit time (col 28 lines 18-25 and claims 6-9). The material may be denim (col 30 lines 12-25). The laser is controlled to scan in lines with varying power (col 20 lines 5-31). The shape may have multiple rounded edges, polygonal portions or form cow-type spots (filled in circles) (col 3 lines 1-13, col 17 lines 4-27, col 18 lines 5-38 and figures 7, 21, 36 and 40). Plaid patterns and polka dots may also be formed (col 19 lines 47-67 and figures 17-18). However, there is no disclosure of the number of colors present or of color assignment.

It would have been obvious to one of ordinary skill in the art at the time of the invention to optimize the process by using at least three assigned colors (dark , light

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and gradual changes in between, Costin, col 17 lines 46-67) yet no more than 20 colors to create intricate graphics (Costin, col 26 lines 47-67 and col 30 lines 30-42) without losing detail (Costin, col 27 lines 24-31) in a simple and cost-effective manner (Costin, col 30 lines 48-53).

6. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin et al. (USPN 6252196 B1) in view of Costin et al. (USPN 5916461).

Costin teaches a method of forming a graphic pattern which can be any shape such as curved and wavy faded lines (camouflage pattern) (col 3 lines 1-14, col 20 lines 8-31 and col 30 lines 30-42) using an interface associated with a computer comprising an output file to control pattern formation on a textile (col 2 lines 1-34 and col 6 lines 4-22). Although the term camouflage is not used, a camouflage pattern is recognized as a random pattern of wavy lines with light and dark areas which may be different colors (col 2 lines 35-39). Regardless of the name given to the pattern the method and structure are identical. The pattern may be defined by a single output file or combination thereof wherein an image is formed in a plurality of locations with different laser parameters to achieve particular characteristics (col 25 lines 35-43 and lines 56-67 and col 25 lines 24-37). Laser intensity may be varied to form multiple colors while operating within a range that will not damage the fabric (col 2 col 17 line 46 – col 18 line 38 and col 26 line 48 – col 27 line 30). Laser output may be expressed in a variety of ways including energy density per unit time (col 28 lines 18-25 and claims 6-9). The material may be denim (col 30 lines 12-25). The laser is controlled to scan in

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lines with varying power (col 20 lines 5-31). The shape may have multiple rounded edges, polygonal portions or form cow-type spots (filled in circles) (col 3 lines 1-13, col 17 lines 4-27, col 18 lines 5-38 and figures 7, 21, 36 and 40). Plaid patterns and polka dots may also be formed (col 19 lines 47-67 and figures 17-18). Although a computer is used to form random patterns and the computer is numerically controlled, there is no disclosure of a random number generator.

Costin teaches a method of forming a graphic pattern which can be any shape such as wavy faded lines (col 1 lines 28-45 and claim 5) using an interface associated with a computer comprising an output file to control pattern formation on a textile. The pattern may be defined by a single output file (col 8 lines 51-56) or combination thereof wherein an image is formed in a plurality of locations with different laser parameters to achieve particular characteristics (col 5 lines 21-43) including color (col 6 lines 33-41). Laser intensity may be varied to form multiple patterns in multiple areas (col 7 lines 16-40 and col 11 lines 19-67) while operating within a range that will not damage the fabric (col 7 lines 49-67 and col 9 lines 21-52). Random patterns are formed with the aid of a random number generator (col 7 lines 37-41 and col 8 lines 1-12). The shape may have rounded edges, polygonal portions or form cow-type spots (filled in circles) (col 7 lines 30-35 and figure 10c). See Costin claims 5-10.

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ a random number generator in combination with one of the numerical control computers to generate the random patterns (Costin '196, col 6 lines 9-22) in a reliable and cost-effective manner (Costin, col 1 lines 28-46).

Response to Arguments

7. Regarding applicant's argument that the instant claims do not merely cover forming patterns on textile materials but rather cover forming specific types of patterns on textiles in a new way, in the previous response applicant admitted that both sets of claims define using an output file to form a pattern on denim. The instant response teaches that a camouflage pattern is "difficult to describe in words" but is recognizable. It is recognized as a random pattern with light and dark areas. Naming the pattern does not change the method. Although the '044 patent does not describe the pattern as camouflage (a pattern comprising different shades), claims 14, 20, 31 and 55 teach forming a graphic pattern at different levels of energy density to form different shades without completely penetrating the material. The instant claims teach the exact same method but use the term "camouflage" rather than regions of different shades. However, the method and results are identical. The '044 claims teach fading different parts of the material by applying different energy densities which forms different shades.

Therefore the rejection of claims 1-4, 6-9, 11-17, 26, 27, 29 and 30 as rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-3, 5-8, 46-57, 61, 62 and 64-71 of U.S. Patent No. 5990444 stands and now includes claims 19-24, 28 and 31.

8. In response to applicant's argument that the references do not teach formation of a pattern called "camouflage", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

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order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

A method of using a program (output file) to define a pattern and using the program to control pattern formation is present. A random pattern having light and dark areas can be formed regardless of the name given to the pattern. The method and device for forming it are the same. A variable power laser is taught and variation of the power is taught in column 6 lines 40-44 with variation in power (energy density) during pattern formation in column 23 lines 38-52.

Therefore the rejection of claims 1-4, 6-9, 11-17, 26, 27, 29 and 30 as rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-3, 5-8, 46-57, 61, 62 and 64-71 of U.S. Patent No. 5990444 stands and now includes claims 19-24, 28 and 31.

9. It is noted that a terminal disclaimer has not been filed.

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., camouflage pattern) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read

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into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore the 102 rejection of claims 13, 15, 20-24, 26, 29 and 30 as anticipated by Costin et al. (USPN 6252196 B1) and the 103 rejection of claim 18 as obvious over Costin et al. (USPN 6252196 B1) stand.

11. Regarding applicant's argument that the pattern is unique for a single application to the textile material see column 3 lines 25-40 which teaches that the method is used to impart identification (pattern) unique to each piece of material and is formed from a program with control. The reference also teaches a unique set of parameters to form a single pattern (col 25 lines 24-38) and use of different power (energy densities) for different colors (col 2 lines 18-28).

Therefore the 102 rejection of claims 13, 15, 20-24, 26, 29 and 30 as anticipated by Costin et al. (USPN 6252196 B1) and the 103 rejection of claim 18 as obvious over Costin et al. (USPN 6252196 B1) stand.

12. Regarding applicant's argument that the instant claims do not merely cover forming patterns on textile materials but rather cover forming specific types of patterns on textiles in a new way, applicant admits that both sets of claims define using an output file to form a pattern on denim. Although the '461 Costin reference does not use the term "camouflage" (a pattern comprising different shades), '461 teaches forming a graphic pattern at different levels of energy density to form random patterns wherein

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different intensity is introduced at different spots on the denim ('461 claims 1 and 3 and col 3 lines 1-16) without completely penetrating the material which will produce differently shaded areas. Laser spot size and output are controlled to achieve the desired look regardless of the name used for the look (col 5 lines 8-58). The instant claims teach the exact same method but use the term "camouflage" rather than regions of different shades as a result of different laser energies applied as a result of probability (col 6 line 42 – col 7 line 35). The '461 claims teach fading different parts of the material by applying different energy densities which forms different shades. Each matrix produces a unique output pattern (col 7 lines 1-9). Differently shaded wavy lines form a camouflage pattern whether that term is used or not. The design may take any shape (col 7 lines 30-35) including wavy lines (col 1 lines 28-45 and claim 5). The instant response teaches that a camouflage pattern is "difficult to describe in words" but is recognizable. It is recognized as a random pattern with light and dark areas. Naming the pattern does not change the method. In both cases, the methods and results are identical. The reference also teaches use of different power (energy densities) for different colors (col 2 lines 18-28).

Therefore the 102 rejection of claims 1-3, 5 and 8-10 as anticipated by Costin et al. (USPN 5916461) stands.

13. In response to applicant's argument that the references do not teach formation of a pattern called "camouflage", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

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order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

A method of using a program (output file) to define a pattern and using the program to control pattern formation is present. A random pattern having light and dark areas can be formed regardless of the name given to the pattern. The method and device for forming it are the same. A variable power laser is taught and variation of the power is taught in column 6 lines 40-44 with variation in power (energy density) during pattern formation in column 23 lines 38-52.

Therefore the 102 rejection of claims 1-3, 5 and 8-10 as anticipated by Costin et al. (USPN 5916461) stands.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lockman et al. (USPN 5567207, laser, pattern not random), Greisz (USPN 5999252, laser marker, random number generator), Carpentier et al. (USPN 6287184 B1), Costin et al. (USPN 6252196 B1), Costin et al. (USPN 6315202 B2), Martin et al. (USPN 6002099), Sanduja et al. (USPN 5741548), McLaughlin (USPN 6090158), Huber et al. (USPN 630144 B1) and Moore (USPN 6246778 B1).

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne Edmondson whose telephone number is (703) 306-5699. The examiner can normally be reached on M-F from 7-4 with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (703) 308-3318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7118 for regular communications and (703) 305-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Lynne Edmondson
Examiner
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A handwritten signature in black ink, appearing to read 'Lynne Edmondson', followed by the date '11/2/02'.

LRE
November 2, 2002